

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BERND WILLING

Appeal No. 2004-2235
Application No. 09/195,005

ON BRIEF

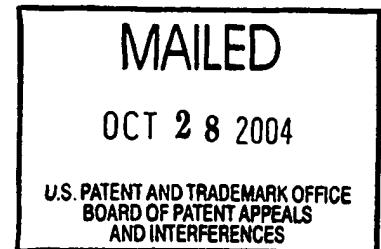
Before FRANKFORT, MCQUADE, and NASE, Administrative Patent Judges.

MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Bernd Willing appeals from the final rejection (mailed October 29, 2003) of claims 7, 11 and 12, all of the claims currently pending in the application.¹

This is the second appeal to this Board involving the instant application. A decision in the first appeal (Appeal No. 2002-0319) issued on September 25, 2002.



¹ The appellant amended claims 7 and 11 and canceled claims 8 and 10 subsequent to the final rejection.

THE INVENTION

The invention relates to a work station wagon conveying device which is defined in representative claim 7 as follows:

7. A device for conveying work station wagons through a plurality of working steps comprising:

a) an oval track around which said work station wagons travel, said oval track comprising i) a first guide strip forming a continuous first oval, ii) a second guide strip spaced apart from said first guide strip and forming a second, larger oval, thereby forming a guide channel which is formed between said two guide strips, iii) a drive chain, comprising carrier cages, travelling [sic] inside said guide channel, and iv) said second guide strip having at least two gaps in its circumference,

b) an insertion guide track located outside said second guide strip, with a portion of said insertion guide track being parallel to a portion of said second guide strip, and having a load-dependent drive in which the maximum speed is higher than the chain speed,

c) a removal guide track, comprising coupling elements selected from the group consisting of switchable electromagnets, rocker heels, and switchable points tongues, located outside said second guide strip, with a portion of said removal guide track being parallel to a portion of said second guide strip,

d) each of said work station wagons having i) at least one first guide roller mounted on a vertically projecting mounting provided on one side of said work station wagon, said first guide roller being removably connected to said drive chain and ii) at least one second guide roller provided on the side of said work station wagon opposite from said first guide roller, said second guide roller connecting said work station wagon to said removal guide track, and iii) a spacer that A) defines the minimum distance between said work station wagons when said work station wagons are engaged with said drive chain and B) contacts the preceding work station wagon engaged with said drive chain, with said device operating as follows:

1) said work station wagons are moved along said insertion guide track by a load-dependant friction drive to a location where said first guide roller pass [sic] through one of said gaps and engage a carrier cage on said drive chain,

Appeal No. 2004-2235
Application No. 09/195,005

2) said work station wagons are conveyed along said oval track, and

3) once said work station wagons reach another one of said gaps, said first guide roller is disengaged from the carrier cage on said drive chain and said workstation wagons are connected via said second guide roller to a coupling element on said removal guide track.

THE REJECTION

Claims 7, 11 and 12 stand rejected under 35 U.S.C. § 112, first paragraph, as being based on a specification which is non-enabling.

Attention is directed to the main and reply briefs (filed May 3, 2004 and July 26, 2004) and to the answer (mailed May 26, 2004) for the respective positions of the appellant and the examiner regarding the merits of this rejection.

DISCUSSION

Insofar as the enablement requirement of 35 U.S.C. § 112, first paragraph, is concerned, the dispositive issue is whether the appellant's disclosure, considering the level of ordinary skill in the art as of the date of the application, would have enabled a person of such skill to make and use the claimed invention without undue experimentation. In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563-64 (CCPA 1982). In calling into question the enablement of the disclosure, the examiner has

Appeal No. 2004-2235
Application No. 09/195,005

the initial burden of advancing acceptable reasoning inconsistent with enablement. Id.

The explanation of the rejection in the answer indicates that the examiner considers the appellant's disclosure to be non-enabling in three basic respects.

First, the examiner refers to a 35 U.S.C. § 112, first paragraph, rejection entered pursuant to 37 CFR § 1.196(b) in the first appeal and submits (1) that the appellant's disclosure is inadequate as to the recitation in claim 7 of the "carrier cages," "coupling elements," "first guide roller" and "second guide roller," and (2) that the problems discussed by this Board in the last five lines on page 5 of the decision in the first appeal have not been overcome. This passage from the earlier decision reads as follows:

the specification fails to describe how the wagons are removably connected to and disconnected from the circulating chain. Nor does it describe a mechanism for moving the wagons along the removal guide track or along the insertion drive track, which would appear to be necessary for the operation of the claimed system, or how the wagons are removably connected to these tracks.

Second, the examiner contends that the wagons will be crushed as they move from the insertion track to the oval track because "[t]here is no disclosure of any control system to only

Appeal No. 2004-2235
Application No. 09/195,005

run the insertion drive at the appropriate time when a void approaches on the loop [i.e., the oval track]. Therefore the friction drive must run continuously and cause the previously mentioned feed problem" (answer, page 3).

Third, the examiner maintains that "there is no disclosure for a control system to operate the switches 27 at the correct time to divert the correct wagon and the correct roller 8 of said wagon to avoid wagon removal errors" (answer, pages 3 and 4).

Taking these points in the order presented, it is noted that the claims involved in the instant appeal differ from those at issue in the earlier appeal. The earlier claims did not refer to a "first guide roller" or a "second guide roller" as does current claim 7. As the underlying specification provides a clear and straightforward description of these elements, a person of ordinary skill in the art would have readily understood their structure and function within the context of the claimed invention. The recitation of the "coupling elements" in current claim 7 is much more detailed than that of the "coupling element" in the earlier claims and also would have been readily understood by a person of ordinary skill in the art within the context of the claimed invention. Although the recitation of the "carrier cages" in current claim 7 arguably is problematic for the reasons

specified in the earlier decision when considered only in light of the sparse description thereof in the underlying specification, the appellant has since submitted evidence,² unchallenged on its merits by the examiner, to show that a person of ordinary skill in the art would have understood the structure and function of these "carrier cages" within the context of the claimed invention. As for the concerns expressed in the passage from the earlier decision reproduced above, suffice to say that such are no longer viable given the content of the current claims and the new evidence and argument of record.

Furthermore, that the appellant's specification lacks a description of any control system to run the insertion drive only at appropriate times does not mean that the insertion drive runs continuously. Even if it is assumed for the sake of argument that such a control system would be necessary for the claimed

² This evidence consists of selected pages from a Bickle, Rader + Rollen catalog and a Ketten Wulf catalog submitted as part of an amendment filed January 9, 2004, which amendment was entered by the examiner (see the advisory action mailed February 20, 2004). In the answer, the examiner states for the first time that these materials "have not been properly filed under 37 C.F.R. 1.97 and 1.98 and therefore not considered by the examiner" (page 5). This belated holding is irrelevant for purposes of this appeal since the materials were submitted as evidence of enablement rather than for consideration under §§ 1.97 and 1.98. As the amendment which included the materials has been entered, the materials are properly before us as evidence bearing on the enablement issue at hand.

Appeal No. 2004-2235
Application No. 09/195,005

device to function in the manner intended, the examiner has not cogently explained, and it is not apparent, why a person of ordinary skill in the art would not have been able, without undue experimentation, to make and use the claimed device in conjunction with such a system.

Finally, notwithstanding the lack of any description in the appellant's disclosure of a control system to appropriately operate switches 27, the examiner has again failed to cogently explain, and it is not apparent, why one of ordinary skill in the art would not have been able, without undue experimentation, to make and use the claimed device with such a control system.

Thus, taking into account the scope of claims 7, 11 and 12 and the evidence and argument now of record, the examiner's position that the appellant's disclosure is non-enabling with respect to the subject matter recited in these claims is unpersuasive.

Accordingly, we shall not sustain the standing 35 U.S.C. § 112, first paragraph, rejection of claims 7, 11 and 12.

Appeal No. 2004-2235
Application No. 09/195,005

SUMMARY

The decision of the examiner to reject claims 7, 11 and 12
is reversed.

REVERSED

Charles E. Frankfort

CHARLES E. FRANKFORT)
Administrative Patent Judge)

) BOARD OF PATENT

John P. McQuade

JOHN P. MCQUADE)
Administrative Patent Judge)

) APPEALS AND

) INTERFERENCES

Jeffrey V. Nase

JEFFREY V. NASE)
Administrative Patent Judge)

)

)

)

)

JPM/kis

Appeal No. 2004-2235
Application No. 09/195,005

PATENT DEPARTMENT
BAYER CORPORATION
100 BAYER ROAD
PITTSBURGH, PA 15205-9741